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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 08/872,659 | 06/10/97 | NAGY | S 016199/1110 |

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EXAMINER

RABAGO, R

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 04/06/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
08/872,659

Applicant(s)
Nagy et al.

Examiner
R. Rabago

Group Art Unit
1713



☒ Responsive to communication(s) filed on Jan 12, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 22-35, 37-51, and 53-73 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 22-35, 37-51, and 53-73 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. The remarks filed 1/12/2000 are acknowledged.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 71-73, 22-35, 37-51, and 53-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reichle et al. (US 5,852,146) for the reasons set forth in item 3 of Paper No. 12, mailed 10/7/99.

Applicant's arguments have been fully considered but they are not persuasive. The fundamental issue is whether the instant claims are fully supported by, and therefore entitled to, the filing date of the parent application. Note MPEP 2133.01:

When applicant files a continuation-in-part whose claims are not supported by the parent application, the effective filing date is the filing date of the child CIP.

More particularly, see the decision in *Paperless Accounting, Inc. v. Bay Area Rapid Transit System* ((CAFC) 231 USPQ 649), wherein the court reiterated that the subject matter of claims presented in a CIP are entitled to the filing date of the parent only for subject matter disclosed in and supported by the parent disclosure. If there are claims in the CIP child application which are

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not entitled to the CIP parent filing date because they comprise "new matter" appearing for the first time in the CIP child, as to those claims applicants must meet the requirements of patentability as if the intervening reference were an adverse reference. Accordingly, an analysis of claim priority in the instant application is in order. The instant claims comprise all of the material claimed in the parent in addition to new material disclosed in the CIP child, and therefore amount to a broadening of the patented claims of the parent application. Looking at the most broad claim (71), the new matter disclosed in the CIP child application comprises: (a) additional species for Y, R, R', X, L and M, and (b) additional values corresponding to parameters **a**, **b** and **c**.

Because all of the instant claims recite at least one component comprising newly disclosed subject matter, none of the claims are entitled to the CIP parent filing date. Further support for this position may be found in applicant's traversal arguments of record. In arguments filed 9/17/99 (pg. 10, second paragraph), applicants state that the additional subject matter disclosed and claimed in the present application was not disclosed in the parent application at all. In arguments filed 2/22/99 (pg. 14, last paragraph through pg. 17, line 3), applicants argue at length that the additional species not disclosed in the parent application are not obvious over the parent disclosure. As the additional claimed subject matter was not disclosed in the parent and is not obvious over the parent, there is no basis for granting priority of the instant claims to the parent application.

Applicants argue at length regarding issues of appropriateness and scope pertaining to potential declarations under either 37 CFR 1.131 or 1.132. The argument regarding 132

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declarations is off-point, because the issue is whether or not the instant claims are entitled to the priority date of the parent. Regarding a showing of prior reduction to practice, applicants allege that the '660 patent, with its declaration, provides an effective showing of prior reduction to practice sufficient to remove the Reichle reference. This point is not contested regarding subject matter which was disclosed in the parent. However, the parent application and its associated declaration provide no evidence of prior invention regarding subject matter which was not disclosed in the parent application. In fact, the record contains no evidence whatsoever of prior conception or reduction to practice by applicants regarding subject matter which was not disclosed in the parent application.

It is noted that the instant claims contain a substantial amount of subject matter which is either supported by the parent (and therefore not rejectable over Reichle) or entirely missing from Reichle. However, applicants have chosen to draft the claims in such a way as to incorporate into every claim subject matter which was not disclosed in the parent and which was disclosed in Reichle, and therefore the rejection is maintained.

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Conclusion


4. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

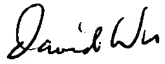
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rabago whose telephone number is (703) 308-4347. The examiner can normally be reached from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful and the matter is urgent, the examiner's supervisor, David Wu, can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are: (703) 305-5408 (official), (703) 305-3599 (official after final) and (703) 306-3429 (unofficial).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

RRabago 
April 5, 2000


DAVID W. WU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700